

## **REMARKS**

### **Reconsideration And Allowance Are Respectfully Requested.**

Claims 1-5, 7-13 and 15-20 are currently pending. Claims 1, 7, 11 have been amended. Claims 6 and 14 have been canceled. No new matter has been added. No new claims have been added. Reconsideration is respectfully requested.

With regard to the rejections based upon prior art, claims 1, 4, 5, 8 and 10 stand rejected as being anticipated by GB Patent No. 2258411 to Roberts (Roberts). Claims 1-5, 8 and 10 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,280,914 to Selby et al. (Selby). Claims 1-5, 8 and 10 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Roberts. Claims 1-5, 8, 10, 11-15, 18 and 20 stand rejected under 35 U.S.C. §103(a) as being obvious over Roberts in view of U.S. Patent Application Publication No. 2002/0195772 to Tweedy (Tweedy). Claims 6, 7, 16 and 17 stand rejected under 35 U.S.C. § 103(a) as obvious over Roberts in view of U.S. Patent No. 4,637,799 to Bouchal (Bouchal). Claims 9 and 19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Roberts in view of U.S. Patent No. 6,672,590 to Olsen et al. Claim 11 stands rejected under 35 U.S.C. §103(a) as being obvious over Selby in view of Tweedy. These rejections are respectfully traversed based upon the preceding amendments and the remarks which follow.

In an effort to define around the prior art of record, the apparatus set forth in independent claim 1 has been amended so as to define a board game facilitating the transfer of knowledge concerning a family playing the game. The board game includes a game board upon which a

plurality of game pieces are moved as the game is played. The game board includes a plurality of game spaces upon which the game pieces are moved so as to determine the action a player is required to take, wherein a portion of the game spaces designate a plurality of different categories concerning various aspects of family knowledge. The board game further includes a plurality of category question cards. Each category question card corresponds to a specific category designated upon the various game spaces included in the board game. The board game also includes a plurality of family photographs players are asked to identify during the playing of the game and a photo album in which the family photographs are stored. In practice, players move game pieces about the game board landing upon various game spaces and answering questions or acting in the manner required by the game space upon which the player lands. The players collect category question cards from the various categories until such a time that one player has collected at least one category question card from each of the plurality of categories.

In establishing the law governing obviousness-type rejections, the Supreme Court in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966), stated:

Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy. . . This is not to say, however, that there will not be difficulties in applying the nonobviousness test. What is obvious is not a question upon which there is likely to be uniformity of thought in every given factual context. The difficulties, however, are comparable to those encountered daily by the courts in such frames of reference as negligence and scienter, and should be amenable to a case-by-case development. We believe that strict observance of the requirements laid down here will result in that uniformity and definitiveness which Congress called for in the 1952 Act.

With the foregoing in mind, the U.S. Patent & Trademark Office has determined that a prima facie case of obviousness is established by meeting three basic criteria. First, the Examiner must show some suggestion or motivation to modify the reference or to combine reference teachings. Second, the Examiner must show a reasonable expectation of success in modifying the primary reference based upon the teachings of the prior art. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Support for the proposed modification and the reasonable expectation of success must be found in the prior art. MPEP 706.02(j). It has further been determined that "[w]here a reference is relied on to support a rejection, whether or not in a minor capacity, that reference should be positively included in the statement of the rejection." See *In re Hoch*, 428 F.2d 1341, 1342 n.3 166 USPQ 406, 407 n. 3 (CCPA 1970).

In contrast to the claimed invention, and as the Examiner has indicated, both Selby and Roberts fail to disclose a board game employing a photo album as claimed. The Office Action attempts to remedy this deficiency by applying the teachings of Bouchal. However, and as discussed below, it is Applicant's opinion that the application of Bouchal in modifying either Selby or Roberts is inappropriate and improper. In particular, Roberts discloses a question and answer board game. The board game includes a plurality of cards relating to various categories utilized during the game. Among the cards are "famous faces". The "famous faces" cards are housed in boxes just as the cards of other categories are housed within the boxes. In particular, Roberts states, "[t]hese said category question/answer cards whose rules appear in 54 are shown in Fig. 7, being housed in three identical boxes 33 as shown in Fig. 2 with category section dividers 34 dividing the cards into the

said six categories”. It is, therefore, explicitly intended by Roberts intends that all category cards be housed together to facilitate ease of use and operation of the game.

In contrast to the teachings of Roberts, Bouchal provides an album for pictures. Bouchal provides the album as part of his disclosed game, which requires the review of a fixed matrix of visual representations. This is entirely different from the intention of the game disclosed by Roberts and the game claimed in accordance with the present invention.

While the album disclosed by Bouchal might “provide amusement and further enhance the entertainment value of the game for participants” of the game disclosed by Bouchal, the album disclosed by Bouchal would have no value to the game contemplated by Roberts other than to make the game more difficult to play since cards would continuously need to be removed and inserted from the album as the game is played. In contrast to the album provided by Bouchal, Roberts provides boxes which hide the cards from view until such a time that the card is in play. The boxes further provide easy access to the cards such that they may be removed and reviewed during the course of playing the game. Such advantages of playing the boxes provided by Roberts are not contemplated by the album disclosed by Bouchal and, therefore, it is Applicant’s opinion that the application of Bouchal as suggesting the modification of Roberts so as to read upon a board game including an album is considered to be inappropriate.

With regard to the game disclosed by Selby, it similarly includes a series of cards bearing pictures of historical figures. As with Roberts, it would entirely inappropriate to modify Selby so as to employ an album as disclosed by Bouchal. It is, therefore, Applicant’s opinion that any rejection based upon the combination of Selby and Bouchal would also be considered inappropriate.

With the foregoing in mind, it is Applicant's opinion that amended claim 1 overcomes the prior art of record. Applicant, therefore, respectfully requests that all outstanding rejections be withdrawn. As to those claims dependent upon independent claim 1, they are believed to overcome the prior art of record for the reasons presented above.

With regard to the method claims defined in claims 11-20, claim 11 has been amended so as to define a method for playing a board game. The method is achieved by preparing a plurality of category question cards relating to various categories concerning a family playing the game. The step of preparing category question cards includes asking family members playing the game to prepare category cards. The method further includes collecting a plurality of family photographs and organizing the family photographs for use during the playing of the game, players taking turns moving individual game pieces about the board game, providing players with the category question card when the player correctly answers the question on the category question, and continuing the game until such a time that one player collects at least one category question card from each of the plurality of categories.

In contrast to the prior art cited in the outstanding Office Action, nothing discloses or suggests the step wherein category question cards are prepared by family members playing the game. Each of the references cited by the Examiner employs category cards which are prepared prior to playing the game and the preparation of cards is not left to those individuals playing the game.

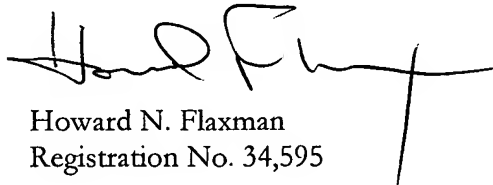
This distinction is very important when the intentions of the present game are considered. The present game is designed for facilitating the learning process between new and old family members and encouraging family members to learn more about their respective families. Without

allowing family members to prepare the category question cards, the personal aspect of the present game would be missing and the entire premise of the present invention would be missed.

With this in mind, Applicant respectfully requests that the rejection of claim 11 be withdrawn. As to those claims dependent upon claim 11 they are believed to overcome the prior art of record for the reasons presented above. In addition, and with reference to claim 16, this claim is further believed to be allowable for the reasons presented above with regard to independent claim 1.

It is believed that this case is in condition for allowance and reconsideration thereof and early issuance is respectfully requested. If it is felt that an interview would expedite prosecution of this application, please do not hesitate to contact applicants' representative at the below number.

Respectfully submitted,



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